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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,863	08/27/2001	Michael Milbocker	Praxis-3	7242

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Manchester, MA 01944

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,863

Applicant(s)

MILBOCKER, MICHAEL

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 18-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Election/Restrictions

Claims 14-16 and 18-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made ~~without~~ traverse in Paper No. 3 filed August 22, 2003.

Specification

The disclosure is objected to because of the following informalities:

On page 1, there is no clear continuing data listed on the first few lines.

Therefore, the Examiner suggests that one be inserted before the first line.

In claim 9, it appears that the word "light" is a misspelling for the word "lightly."

In claim 9, it appears that the word "soldier" is a misspelling for the word "solder."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al (US 5,445,597). Clark anticipates the claim language where the prosthetic as claimed is the pad (36) of Clark; see Figures 1 and 10 as well as column 3, lines 50-62 and column 4, lines 6-24.

Claims 1-4, 10, 11, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhu et al (6,589,269). Zhu anticipates the claim language where the prosthesis as claimed is the patch (60) of Zhu, and the adhesive of Zhu is applied to the site once the pad is in place; see Figures 3, 4, and 4A as well as column 6, lines 5-35.

With regard to claim 2, Applicant is directed to see Figure 5.

With regard to claim 3, Applicant is directed to see column 8, lines 43-46.

With regard to claims 10 and 11, Applicant is directed to see column 4, lines 1-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (US 5,445,597) of Zhu et al (US 6,589,269) in view of English et al (US 4,804,691). Clark and Zhu meet the claim language as explained above, but fail to disclose the types of other adhesives therewith as claimed. However, English teaches that fibrin, polyurethane, and polyisocyanate adhesives were known and available to the art at the time the invention was made; see column 1, lines 21-61. Therefore, it would have been prima facie obvious to an ordinary artisan to substitute any of these other known surgical adhesives for the adhesive of either Clark or Zhu for the same reasons that the prior art used the same and to adapt the device to the particular patient's need.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (US 5,445,597) or Zhu et al (US 6,589,269) in view of Owen et al (US 6,211,335). Clark and Zhu disclose the use of cyanoacrylate adhesives therewith, but fail to disclose the use of albumin solder as claimed. However, Owen teaches that it was known to use albumin solder in similar tissue bonding methods; see column 9, lines 7-14. Hence, it is the Examiner's position that it would have been prima facie obvious to substitute or combine the albumin solder of Owen for/with the adhesives of either Clark or Zhu for the same reasons that Owen uses the same and in order to adapt the Clark or Zhu devices to the particular patient need.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (US 5,445,597) or Zhu et al (US 6,589,269) in view of Ganster et al (US 6,191,216).

Clark and Zhu disclose the use of cyanoacrylate adhesives therewith but fail to disclose the use of open cell polyurethane adhesive as claimed. However, Ganster teaches that is was known to use foamed (open cell) polyurethane adhesive in similar tissue bonding methods; see column 1, lines 11-39 and column 6, lines 38-47. Hence, it is the Examiner's position that it would have been prima fascia obvious to substitute or combine the foamed adhesive of Ganster for/with the adhesives of either Clark or Zhu for the same reasons that Ganster uses the same and in order to adapt the Clark or Zhu devices to the particular patient need.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu et al (US 6,589,269) alone. Zhu meets the claim language as set forth above, but fails to disclose the repair of an inguinal hernia as claimed. However, since Zhu et al teaches that the method thereof can be used for any internal surgical repair (see column 4, lines 5-11), it would have been obvious to use the Zhu device to repair an inguinal hernia so as to help such patients also.

Allowable Subject Matter

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

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Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read "Paul Prebilic", with a long horizontal line extending to the right.

Paul Prebilic
Primary Examiner
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